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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,042	03/17/2001	Stuart L. Axelson JR.	S-003 (Systems)	5681

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EXAMINER

PRIDDY, MICHAEL B

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/811,042

Applicant(s)

AXELSON ET AL.

Examiner

Michael B Priddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 17 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-4, 8, 9, 11, 12, 16-18, 21, 23, 24, 28, 30, 32, 33 and 36-39 is/are rejected.
- 7) ☐ Claim(s) 5-7, 10, 13-15, 19, 20, 22, 25-27, 29, 31, 34, 35 and 40-42 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the computer navigation system must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 3 and 18 each use the language "infinitely variable" in line 2 while the specification uses the language "infinitely adjustable" (see lines 6-8 of page 4).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 31 recites the limitation "said tibial anchoring means" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 8, 9, 11, 12, 16-18, 21, 23, 24, 28, 30, 32, 33 and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morawa et al. (5,788,700) in view of Matsen, III et al. (5,690,635). Morawa et al. teach an apparatus and method for the alignment of a total knee prosthesis which includes a clamp 60 for anchoring the system to the distal tibia, a resection guide 90 which is attached to the clamp 60 via an alignment assembly 70. Resection guide includes sockets in its proximal surface for receipt of connecting elements for the attachment of other instruments such as stylus assembly 120 or a computer navigation system. Assembly 70 includes an upper shaft portion 40 telescopically received in lower tubular member 46 which allows for proximal-distal movement of the resection guide 90 with respect to the anchoring clamp 60. A first carriage 72 allows for anterior-posterior sliding movement along a first guideway 74

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which is carried by a second carriage 76 allowing for medial-lateral sliding movement along a second guideway 78. The apparatus further includes an extra-medullary alignment rod 20 which may be removably connected to the resection guide via slot 150 of block 142.

Concerning claims 4 and 30, pins 160 could alternatively be considered the anchoring means upon its/their insertion through pin holes 94.

Hence Morawa et al. teach all of the limitations of the present invention except that the apparatus includes a computer navigation system.

Matsen, III et al. teaches a prosthesis template for use in a robot-aided system for surgery. A saw guide 215 is attached to a coupler 160 which attaches various tools to robot wrist 154. The robot 54 is controlled by a controller 55 which directly controls and monitors the movement of the robot. A supervisor 56 in the form of a personal computer 66 supervises the communications between the robot 54 and the controller 55. It would have been obvious to one of ordinary skill in the art at the time of the present invention to have incorporated the robotic navigation system of Matsen, III et al. with the apparatus of Morawa et al. in order to ensure perfect or near perfect alterations are routinely achieved to thereby avoid poor knee mechanics and/or loosening of prosthetic components due to imperfect fit as a result of imperfect resection.

#### ***Allowable Subject Matter***

Claims 5-7, 10, 13-15, 19, 20, 22, 25-27, 29, 31, 34, 35 and 40-42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

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independent form including all of the limitations of the base claim and any intervening claims.

Claim 31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

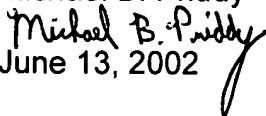
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on (703) 308-2698. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



NICHOLAS D. LUCCHESI  
PRIMARY EXAMINER  
GROUP 3300

Michael B. Priddy

  
June 13, 2002